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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,265	08/03/2001	Masashi Eguchi		2522

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LOS ANGELES, CA 90071-2611

EXAMINER

BAKER, CHARLOTTE M

ART UNIT PAPER NUMBER

2626

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/923,265

**Applicant(s)**

EGUCHI, MASASHI

**Examiner**

Charlotte M. Baker

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-20 is/are allowed.
- 6) ☒ Claim(s) 1,2,8 and 14-17 is/are rejected.
- 7) ☒ Claim(s) 3-7 and 9-13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 8, 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Shoujima (5,754,778).

**Regarding claim 1:** Shoujima discloses receiving means (Fig. 1, receiving terminal 20) for receiving electronic mail by the packet (email divided into portions) when a size of said electronic mail exceeds a size (available capacity) of electronic mail which can be received by the device (Fig. 1, receiving terminal 20) (col. 3, ln. 23-30); and sending means (Fig. 1, mail server 10) for sending said each packet (email divided into portions) of the electronic mail to a designated address when the size of said electronic mail exceeds the size (available capacity) of electronic mail which can be received by the device (Fig. 1, receiving terminal 20) (col. 3, ln. 31-40).

**Regarding claim 2:** Shoujima satisfies all the elements of claim 1. Shoujima further discloses wherein said device is a facsimile server (Fig. 1, mailer server 10), the facsimile server is connected to an electronic mail server (sending terminal, col. 2, ln. 65-67 through ln. 7), and the facsimile server (Fig. 1, mailer server 10) receives the electronic mail from the electronic mail server (sending terminal, col. 2, ln. 65-67 through ln. 7) which has reached the electronic mail

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server (sending terminal, col. 2, ln. 65-67 through ln. 7) and is addressed to the facsimile server (Fig. 1, mailer server 10).

**Regarding claim 8:** Shoujima satisfies all the elements of claim 1. Shoujima further discloses wherein said device is an electronic mail device (Fig. 1, mail server 10), the electronic mail device (Fig. 1, mail server 10) is connected to an electronic mail server (sending terminal, col. 2, ln. 65-67 through ln. 7), and the electronic mail device (Fig. 1, mail server 10) receives the electronic mail from the electronic mail server (sending terminal, col. 2, ln. 65-67 through ln. 7) which has reached the electronic mail server (sending terminal, col. 2, ln. 65-67 through ln. 7) and is addressed to the electronic mail device (Fig. 1, mail server 10).

**Regarding claim 14:** The structural elements of apparatus claim 1 perform all of the steps of method claim 14. Thus, claim 14 is rejected for the same reasons discussed in the rejection of claim 1.

**Regarding claim 15:** Shoujima satisfies all the elements of claim 14. Shoujima further discloses referring for the size of the electronic mail (col. 3, ln. 10-13); detecting the receivable size (col. 3, ln. 10-18); and comparing the size of the electronic mail with the receivable size (col. 3, ln. 10-18 and col. 3, ln. 37-40).

**Regarding claim 16:** Shoujima satisfies all the elements of claim 15. Shoujima further discloses wherein the electronic mail is received via an electronic mail server (received from sending terminal at mail server 10) and the electronic mail server which the electronic mail has reached is asked of the size of the electronic mail (comparing capacity of receiving terminal 20 to the size of the email, col. 3, ln. 10-18 and 37-40) (The portions of email are sent to the

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receiving terminal 20 from the mail server 10 based upon available memory capacity in memory section 24, which is a component of receiving terminal 20, see Fig. 1).

**Regarding claim 17:** Shoujima satisfies all the elements of claim 14. Shoujima further discloses receiving a plurality of packets of electronic mail (col. 3, ln. 18-30) and thereby restoring the electronic mail when the size of the electronic mail is smaller than the receivable size (the email is portioned according to the available capacity in the memory section 24 and col. 3, ln. 41-44).

#### *Allowable Subject Matter*

3. Claims 3-7 and 9-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
4. Claims 18-20 are allowed.

#### *Conclusion*

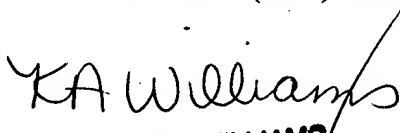
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlotte M. Baker whose telephone number is (571)272-7459. The examiner can normally be reached on Monday-Friday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571)272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CMB

  
KIMBERLY WILLIAMS  
SUPERVISORY PATENT EXAMINER